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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,137	02/27/2002	Douglas A. Deder	HYS-38CIP	3337
	7590	01/30/2004	EXAMINER	
Luisa Bigornia HYSEQ, INC. 670 Almanor Avenue Sunnyvale, CA 94085			ALLEN, MARIANNE P	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/087,137

**Applicant(s)**

DEDERA ET AL.

**Examiner**

Marianne P. Allen

**Art Unit**

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 40 is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Applicant is advised that the originally filed claims contained two claims numbered 38.

The second claim numbered 38 (following claim 39) has been renumbered as claim 40 in accordance with 37 CFR 1.126.

Claim 40 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim (see claims 36 and 37). See MPEP § 608.01(n). Accordingly, the claim 40 has not been further treated on the merits.

Note that claim 37 refers to the method of claim 35; however, claim 35 is a composition.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 13-15, 23, and 35, drawn to drawn to polynucleotides, vectors, host cells, and a method of using the polynucleotide, classified in class 536, subclass 23.1.
- II. Claims 9-12 and 24, drawn to polypeptides, classified in class 530, subclass 399.
- III. Claim 16, drawn to antibodies, classified in class 530, subclass 387.1.
- IV. Claims 17-19, drawn to methods for detecting polynucleotides, classified in class 435, subclass 6.
- V. Claims 20, drawn to methods for detecting polypeptides, classified in class 435, subclass 7.1.
- VI. Claims 21-22, drawn to methods for identifying binding compounds, classified in class 435, subclass 69.1.
- VII. Claim 25-27, drawn to polynucleotide arrays, classified in class 422, subclass 68.1.
- VIII. Claims 28-29 and 36, drawn to methods of treatment involving IGFBP-7-HY-1 by administering a polypeptide, classified in class 514, subclass 12.
- IX. Claims 28-29, 34 and 36-37, drawn to methods of treatment involving IGFBP-7-HY-1 by administering polynucleotides, classified in class 514, subclass 44.

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- X. Claims 28-29, and 36, drawn to methods of treatment involving IGFBP-7-HY-1 by administering agonists or antagonists, classified in at least class 530, subclass 324, for example.
- XI. Claims 30, 32, and 36, drawn to a method of suppressing the growth of a cancer cell using a polynucleotide, classified in class 514, subclass 44.
- XII. Claims 31, 33, and 36, drawn to a method of suppressing the growth of a cancer cell using a polypeptide composition, classified in class 514, subclass 12.
- XIII. Claims 38-39, drawn to a method of diagnosing cancer, classified in at least for example, class 435, subclass 7.1.

In addition, each SEQ ID NO. recited in the claims is considered to be a different invention as polynucleotides and polypeptides have different structures and functions and each of the polynucleotides and polypeptides appears to be different. It does not appear that any SEQ ID NO. is completely and/or identically contained within any other SEQ ID NO. Applicant is required to elect a single sequence for examination. Should any other SEQ ID NO. be completely and/or identically contained within the elected sequence, applicant should specifically identify these sequences. These sequences will be examined in addition to the elected sequence. The claims will be examined only to the degree that they reflect these sequences and this election should not be construed as a species election.

Claims 28-29 are present in multiple groups as these claims are directed to multiple distinct inventions. If these claims are elected, applicant should make clear which group is being elected. These claims as well as the associated dependent claims (e.g. claim 36) will only be examined to the degree that they reflect the inventive concept as set forth in that group.

The inventions are distinct, each from the other because of the following reasons:

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The products of groups I, II, III, and VII can be shown to be distinct because they differ structurally and functionally. The methods of groups V, VI, and VIII-XIII can be shown to be distinct because they have different starting materials, method steps, and/or goals. Each of the products can be shown to be distinct from each of the methods because the method either does not use the product or the product can be used in multiple methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. In addition, each of the inventions would require a non-coextensive literature search.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

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A handwritten signature in cursive script that reads "Marianne P. Allen".

Marianne P. Allen

Primary Examiner

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